

Appl. No. : 10/804,768
Filed : March 19, 2004

REMARKS

In response to the Office Action mailed March 27, 2006, Applicant has amended the application as above. No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the remarks set forth below.

Discussion of Claim Amendments

Claims 11 and 21 have been cancelled, without prejudice. Claim 1-2, 5-7, 10, 14 and 16-20 have been amended. Upon the entry of the amendments, Claims 1-10 and 12-20 are pending in this application. The amendments to the claims are supported by Figure 1 and its corresponding description, for example. Thus, no new matter is added by the amendments. Applicant respectfully requests the entry of the amendments.

Discussion of Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1-6 under 35 U.S.C. § 102(b) as being anticipated by Abramson (U.S. Patent No. 5,951,667). Applicant respectfully submits that all pending claims are allowable over the cited prior art as discussed below.

Standard of Anticipation

“For a prior art reference to anticipate a claim under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.ed 675, 677, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988).

Discussion of Patentability of Independent Claims 1, 7, 10, 14 and 18

Independent Claim 7, as amended, recites, among other things, that at least one *second PCI bus device* is electrically coupled to the bus interface extender. Each of independent Claims 1, 10, 14 and 18 includes a similar feature thereto. Applicant respectfully submits that Abramson does not disclose the above-indicated feature of the claimed invention.

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Abramson discloses an integrated expansion bus bridge arbiter (630), acknowledged by the Examiner corresponding to the claimed extender, which is connected to i) a USB host controller (640), ii) an ISA bus controller (670) and iii) an IDE controller (680). The arbiter (630) coordinates a PCI bus access request between the three controllers (640, 670 and 680) and the PCI arbiter. *See column 7, lines 20-23 and Figure 5.* Since these controllers are not a PCI bus device, Abramson does not disclose the feature “at least one *second PCI bus device* is electrically coupled to the bus interface extender” of the claimed invention. Thus, Applicant respectfully submits that Abramson does not anticipate the claimed invention.

According to one embodiment of the claimed invention, the number of the PCI bus devices, which are controlled by the PCI bus arbitrator (10), can be significantly increased without redesigning circuit or replacing the original bus arbitrator (10). *See the specification of this application at page 5, lines 4-8.* Since in Abramson non-PCI bus devices (controllers 640, 670 and 680) are connected to the bus bridge arbiter (630), the Abramson device cannot provide the above-indicated benefit.

Furthermore, Applicant respectfully submits that there is no motivation to modify the Abramson apparatus such that the controllers (640, 670 and 680) are replaced with PCI bus devices. Abramson teaches that in order to provide integration of the three controllers (640, 670 and 680) and efficient coordination of a PCI bus access request, the Abramson device requires the three controllers (640, 670 and 680) connected to the integrated expansion bus bridge arbiter (630). *See column 2, lines 4-7, 16-17 and 24-28, and column 7, lines 20-23 and Figure 5.*

Replacing the controllers (640, 670 and 68) with PCI bus devices would render the modified apparatus unsatisfactory or inoperable for its intended purpose. *MPEP 2143.01.* Thus, Applicant respectfully submits that there is no motivation to modify the Abramson apparatus to arrive at the claimed invention. In view of the above, Applicant respectfully submits that all independent claims are allowable over Abramson.

Discussion of Patentability of Dependent Claims

Claims 2-6, 8-9, 12-13, 15-17 and 19-20 depend from base Claim 1, 7, 10, 14 or 18, and further define additional technical features of the present invention. In view of the patentability of

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their base claims, and in further view of their additional technical features, Applicant respectfully submits that the dependent claims are patentable over the prior art of record.

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CONCLUSION

In view of Applicant's amendments to the claims and the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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